

Application No. 10/807,079

### REMARKS

Claims 1-50 are pending in the application. Claims 1-19 and 24-46 are currently rejected. Claims 20-23 and 47-50 are withdrawn from consideration as being directed to a non-elected invention.

The Office Action states that the subject application contains 4 independent claims; 1, 20, 24, and 47. The Office Action further states that mere reference to a previous claim does not make a claim dependent. The applicant hereby submits the required fee for the one independent claim in excess of 3.

Claims 1-19 and 24-46 are rejected under 35 U.S.C. 102(b or e) as allegedly anticipated or in the alternative, under 35 U.S.C. 103(a) as allegedly obvious over Prasad et al, Hirokawa et al, Truong or Lombardo et al. The Office Action states that each reference teaches that a polishing pad comprising hydrophilic and hydrophobic material is conventional. The Office Action further states that based upon the disclosure in each of the above references, the elements recited in all of the pending claims would also have been obvious, if not disclosed, for the purpose of facilitating the provision of a better performing pad.

The applicant respectfully disagrees. Applicant acknowledges that the listed references discuss the need of having some hydrophilic nature to a hydrophobic pad in order to improve slurry distribution over the surface of the pad. The Truong reference discloses seasoning, or wetting, a hydrophobic pad by contacting the pad with isopropyl alcohol. Lombardo discloses a polishing pad made from a hydrophobic polymeric matrix containing a hydrophilic additive interspersed therein. Hirokawa et al teach adding a hydrophilic substance to a resin for casting a hydrophobic pad. Prasad et al describe a multi-layer pad, said pad layers being all hydrophobic, all hydrophilic or alternating between layers. Whatever else the above mentioned references teach, they do not teach a polishing pad substrate comprising either a copolymer having at least one hydrophilic repeat unit and at least one hydrophobic repeat unit, or a polymer having at least one hydrophilic unit and at least one hydrophobic unit attached to the polymer chain. Therefore, none of the above mentioned references can be considered anticipatory prior art.

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Additionally, there is no suggestion or motivation in any of the above mentioned references to combine or modify the teachings in order to prepare a polishing pad of the instant application. In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (a) the prior art references must teach or suggest all the claim limitations, (b) there must be some suggestion or motivation to modify the reference or to combine reference teachings, and (c) there must be a reasonable expectation of success. See e.g., M.P.E.P. § 2143. Applicant respectfully traverses the obviousness rejections because at least two of the criteria are not met.

Claims 1-19 and 24-46 are rejected under 35 U.S.C. 103(a) as allegedly obvious over Hiwatashi et al. The Office Action states that Hiwatashi discloses most of the elements of the claims including a cosmetic comprising the hydrophilic and hydrophobic materials recited in the claims. The Office Action admits that Hiwatashi lacks a teaching of a polishing pad substrate, but asserts that it would be obvious to provide the Hiwatashi materials on some sort of pad to facilitate application of the materials to the body. The Office Action states that claim 1 of the subject application reads on such a pad because the phrase "polishing pad substrate" as used by itself, does not limit the claims to polishing pads of the type disclosed in the subject application.

Applicants respectfully disagree. Hiwatashi teaches a cosmetic use polymer for hair, skin or nails, with no compositional similarity at all to the polishing pad substrate comprising a copolymer or polymer of the claimed invention. The term "polishing pad substrate" is a well established term in the art. As an example, applicants point to the prior art described in the background of the invention section of instant application, and in particular to U.S. patents 6,062,968 and 6,126,532. Both of these issued U.S. patents have claims to "polishing pad substrates" of different compositions. Therefore the Hiwatashi reference, taken as a whole, certainly does not suggest or motivate one of skill in the art to make the claimed invention.

For the above mentioned reasons, the applicants assert that claims 1-19 and 24-46 are not anticipated nor are obvious over the cited references. Applicants respectfully request that the rejections under U.S.C. 102 and 103 be withdrawn.

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If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas Omholt", is written over a horizontal line.

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